

REMARKS

In response to the Office Action of October 20, 2003, Applicants have amended the claims, which when considered with the following remarks, is deemed to place the present application in condition for allowance. Favorable consideration of all pending claims is respectfully requested. Amendments and/or cancellation of claims have been made in the interest of expediting prosecution of this case. Applicants reserve the right to prosecute the same or similar subject matter in this or another application.

Claims 1-2, 5-21, 30 and 31 are pending in this application. By this Amendment, Claims 1, 5 and 30 have been amended, Claims 3, 4 and 22-29 have been canceled without prejudice and new Claim 31 has been added. No new matter has been added to subject application nor have any new issues been raised. Moreover, it is believed that the claims as presented herein are in condition for immediate allowance and such is respectfully requested.

The Examiner has rejected original Claims 1-3, 29 and 30 under 35 U.S.C. § 102(b) as being anticipated by Kolsky U.S. Patent No. 5,274,846 ("Kolsky"). Of these claims, Claims 1 and 30 have been amended to include the limitations of Claims 3 and 4 and Claims 3 and 29 have been cancelled.

It is respectfully submitted that the claims, as currently amended, are patentably distinct from Kolsky.

Kolsky discloses a cushion or pad formed from a first layer 10 of a polymeric foam material of either open cell or closed cell construction that is bonded via a layer 12 to a second layer 14 of a polymeric foam material of either open cell or closed cell construction that is bonded via a layer 16 to a third bubble layer 24 (See FIG. 1). Kolsky further discloses a cushion or pad formed from two layers 102 and 104 of bubbles or fluid filled chambers 106 and 108.

Each layer 102 and 104 is formed by a respective web 110 and 112 of polymeric material bonded to a respective bubble film 114 and 116 wherein the bubble side of both layers are facing upwards (See FIG. 11).

In contrast thereto, independent Claim 1, as presently amended, recites a mat comprising “at least two layers of an air bubble shaped closed cellular material having a flat side and a bubble side; and one or more layers selected from the group of materials consisting of closed cellular polyethylene foam and closed cellular polypropylene foam materials wherein said bubble side of one of said layers of air bubble shaped closed cellular material is positioned to face said bubble side of another of said layers of air bubble shaped closed cellular material.”

As Kolsky nowhere discloses a mat as presently recited in amended Claim 1, unquestionably, then, amended Claim 1 recited novel subject matter relative to Kolsky.

There is likewise no suggestion, motivation or even a hint in Kolsky of forming a mat comprising “at least two layers of an air bubble shaped closed cellular material having a flat side and a bubble side; and one or more layers selected from the group of materials consisting of closed cellular polyethylene foam and closed cellular polypropylene foam materials wherein said bubble side of one of said layers of air bubble shaped closed cellular material is positioned to face said bubble side of another of said layers of air bubble shaped closed cellular material” as presently recited in amended Claim 1.

Rather Kolsky merely discloses cushions or pads containing either (1) a bubble layer having two layers of a polymeric foam material of either open cell or closed cell construction thereon (FIG. 1); (2) a bubble layer interposed between two layers of a polymeric foam material of either open cell or closed cell construction thereon (FIG. 3); a bubble layer having one layer of a polymeric foam material of either open cell or closed cell construction thereon (FIG. 4); or two

bubble layers wherein the bubble side of both layers are facing upwards (FIG. 11). At no point is it seen where there is any suggestion, motivation or even a hint in Kolsky of forming a mat comprising “at least two layers of an air bubble shaped closed cellular material having a flat side and a bubble side; and one or more layers selected from the group of materials consisting of closed cellular polyethylene foam and closed cellular polypropylene foam materials wherein said bubble side of one of said layers of air bubble shaped closed cellular material is positioned to face said bubble side of another of said layers of air bubble shaped closed cellular material.”

In the Office Action, the Examiner alleges that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention to have the bubble side of one of the layers of air bubble shaped closed cellular material positioned to face the bubble side of another of the layers of air bubble shaped closed cellular material in Kolsky since it has been held that rearranging parts of an invention involves only routine skill in the art absence of showing unexpected results.” citing *In re Japikse*, 86 USPQ 70. However, no such holding is seen by the court in *In re Japikse*. Instead, the issues dealt with by the court in *In re Japikse* related to inoperativeness of a prior art reference and citation of additional references by the Examiner in an Examiner’s Statement following the appeal to the Board. Accordingly, Applicants respectfully request the Examiner to identify where in *In re Japikse* such holding can be found.

Besides, it is well establish that there must be a sufficient showing of a suggestion or motivation for any modification of the teachings of a reference necessary to reach the claimed invention in order to support the obviousness conclusion. *McGinley v. Franklin Sports Inc.*, 60 USPQ2d 1001 (CA FC 2001). As is the case here, Kolsky provides no suggestion, motivation or even a hint of modifying the cushions or pads for use as knee pads and shin guards, exercise mats, beach pads, stadium seat cushions, wheelchair cushions, bathtub liners, in luggage handles,

pads for shoulder straps, or a liner material for gloves as disclosed therein to arrive at the mat as presently set forth in amended Claim 1. Thus, nothing therein would lead one skilled in the art to modify the cushions or pads of Kolsky to arrive at the presently recited mat comprising “at least two layers of an air bubble shaped closed cellular material having a flat side and a bubble side; and one or more layers selected from the group of materials consisting of closed cellular polyethylene foam and closed cellular polypropylene foam materials wherein said bubble side of one of said layers of air bubble shaped closed cellular material is positioned to face said bubble side of another of said layers of air bubble shaped closed cellular material.” If it is the Examiner’s position that one of ordinary skill in the art, upon inspection of Kolsky, would be motivated to form a mat as presently set forth in amended Claim 1, then the Examiner is respectfully requested to explain with reasons of particularity why one skilled in the art would be motivated to form the presently claimed mat.

Accordingly, in lacking any disclosure, suggestion or motivation of a mat comprising “at least two layers of an air bubble shaped closed cellular material having a flat side and a bubble side; and one or more layers selected from the group of materials consisting of closed cellular polyethylene foam and closed cellular polypropylene foam materials wherein said bubble side of one of said layers of air bubble shaped closed cellular material is positioned to face said bubble side of another of said layers of air bubble shaped closed cellular material”, amended Claim 1 is believed to be nonobvious, and therefore patentable, over Kolsky.

With respect to amended Claim 30, nowhere does Kolsky disclose “a method for decreasing musculoskeletal fatigue in humans resulting from static postural stress in a surgical theatre during open operative procedures which method also facilitates maintaining the surgical theatre in a surgically safe environment comprising the steps of: positioning a completely

disposable mat on the floor of the surgical theatre prior to or during an operative procedure; said mat comprising at least two layers of an air bubble shaped closed cellular material having a flat side and a bubble side; and one or more layers selected from the group of materials consisting of closed cellular polyethylene foam and closed cellular polypropylene foam materials wherein said bubble side of one of said layers of air bubble shaped closed cellular material is positioned to face said bubble side of another of said layers of air bubble shaped closed cellular material; supporting a human on said mat during a period of static postural positioning; and disposing of said mat after the conclusion of the operative procedure.”

Rather, Kolsky discloses cushions or pads containing either (1) a bubble layer having two layers of a polymeric foam material of either open cell or closed cell construction thereon (FIG. 1); (2) a bubble layer interposed between two layers of a polymeric foam material of either open cell or closed cell construction thereon (FIG. 3); a bubble layer having one layer of a polymeric foam material of either open cell or closed cell construction thereon (FIG. 4); or two bubble layers wherein the bubble side of both layers are facing upwards (FIG. 11). Kolsky further discloses that the cushions or pads for use as knee pads and shin guards, exercise mats, beach pads, stadium seat cushions, wheelchair cushions, bathtub liners, in luggage handles, pads for shoulder straps, or a liner material for gloves. Unquestionably, then, does amended Claim 30 recite novel subject matter over Kolsky.

There is likewise no suggestion, motivation or even a hint in Kolsky of a method for decreasing musculoskeletal fatigue in humans resulting from static postural stress in a surgical theatre during open operative procedures which method also facilitates maintaining the surgical theatre in a surgically safe environment comprising the steps of “positioning a completely disposable mat on the floor of the surgical theatre prior to or during an operative procedure; said

mat comprising at least two layers of an air bubble shaped closed cellular material having a flat side and a bubble side; and one or more layers selected from the group of materials consisting of closed cellular polyethylene foam and closed cellular polypropylene foam materials wherein said bubble side of one of said layers of air bubble shaped closed cellular material is positioned to face said bubble side of another of said layers of air bubble shaped closed cellular material; supporting a human on said mat during a period of static postural positioning; and disposing of said mat after the conclusion of the operative procedure” as presently recited in amended Claim 30.

Rather, Kolsky discloses cushions or pads for use as knee pads and shin guards, exercise mats, beach pads, stadium seat cushions, wheelchair cushions, bathtub liners, in luggage handles, pads for shoulder straps, or a liner material for gloves. At no point is there any appreciation in Kolsky of a method for decreasing musculoskeletal fatigue in humans resulting from static postural stress in a surgical theatre during open operative procedures employing the specifically recited mat. Accordingly, in lacking any disclosure, suggestion or motivation of the recited method, amended Claim 30 and new Claim 31 are believed to be nonobvious, and therefore patentable, over Kolsky.

The Examiner has rejected Claim 5 under 35 U.S.C. § 103(a) as being obvious over Kolsky.

Nowhere does Kolsky disclose or suggest a mat comprising “at least two layers of an air bubble shaped closed cellular material having a flat side and a bubble side; and one or more layers selected from the group of materials consisting of closed cellular polyethylene foam and closed cellular polypropylene foam materials interposed between said layers of air bubble shaped closed cellular material wherein said bubble side of one of said layers of air bubble shaped

closed cellular material is positioned to face said bubble side of another of said layers of air bubble shaped closed cellular material” as generally recited in amended Claim 5.

Rather, Kolsky merely discloses cushions or pads containing either (1) a bubble layer having two layers of a polymeric foam material of either open cell or closed cell construction thereon (FIG. 1); (2) a bubble layer interposed between two layers of a polymeric foam material of either open cell or closed cell construction thereon (FIG. 3); a bubble layer having one layer of a polymeric foam material of either open cell or closed cell construction thereon (FIG. 4); or two bubble layers wherein the bubble side of both layers are facing upwards (FIG. 11). At no point is there any disclosure, suggestion or motivation in Kolsky of forming a mat comprising “at least two layers of an air bubble shaped closed cellular material having a flat side and a bubble side; and one or more layers selected from the group of materials consisting of closed cellular polyethylene foam and closed cellular polypropylene foam materials wherein said bubble side of one of said layers of air bubble shaped closed cellular material is positioned to face said bubble side of another of said layers of air bubble shaped closed cellular material.”

In the Office Action, the Examiner alleges that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention to have the bubble side of one of the layers of air bubble shaped closed cellular material positioned to face the bubble side of another of the layers of air bubble shaped closed cellular material in Kolsky and to have provided a layer of the closed cellular polyethylene foam material interposed between the layers of air bubble shaped closed cellular material in Kolsky, since it has been held that rearranging parts of an invention involves only routine skill in the art absence of showing unexpected results.” citing *In re Japikse*, 86 USPQ 70.” However, as stated hereinabove no such holding is seen by the court in *In re*

Japikse. Accordingly, Applicants again respectfully request the Examiner to identify where in *In re Japikse* such holding can be found.

Besides, it is well establish that there must be a sufficient showing of a suggestion or motivation for any modification of the teachings of a reference necessary to reach the claimed invention in order to support the obviousness conclusion. *McGinley v. Franklin Sports Inc.*, 60 USPQ2d 1001 (CA FC 2001). As is the case here, Kolsky provides no suggestion, motivation or even a hint of modifying the cushions or pads for use as knee pads and shin guards, exercise mats, beach pads, stadium seat cushions, wheelchair cushions, bathtub liners, in luggage handles, pads for shoulder straps, or a liner material for gloves as disclosed therein to arrive at the mat as presently set forth in amended Claim 5. Thus, nothing therein would lead one skilled in the art to modify the cushions or pads of Kolsky to arrive at the presently recited mat formed from a layer of the closed cellular polyethylene foam material interposed between the layers of air bubble shaped closed cellular material and wherein said bubble side of one of said layers of air bubble shaped closed cellular material is positioned to face said bubble side of another of said layers of air bubble shaped closed cellular material.” If it is the Examiner’s position that one of ordinary skill in the art, upon inspection of Kolsky, would be motivated to form a mat as presently set forth in amended Claim 5, then the Examiner is respectfully requested to explain with reasons of particularity why one skilled in the art would be motivated to form the presently claimed mat.

In lacking any suggestion or motivation to form the presently recited mat, amended Claim 5 is believed to be nonobvious, and therefore patentable, over Kolsky. Accordingly, withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

The Examiner has rejected Claims 6-12 under 35 U.S.C. § 103(a) as being obvious over Kolsky in view of Small U.S. Patent No. 4,644,592 ("Small").

The deficiencies of Kolsky discussed above with respect to the rejection of amended Claim 1 applies with equal force to this rejection. Small does not cure and is not cited as curing the above-noted deficiencies of Kolsky. Rather, Small is merely cited for its disclosure of a base layer including a low tack adhesive bottom surface and a removable liner releasably attached to the lower surface of the low-tack adhesive.

Since Kolsky and Small, alone or in combination, do not teach or suggest a mat comprising, comprising "at least two layers of an air bubble shaped closed cellular material having a flat side and a bubble side; and one or more layers selected from the group of materials consisting of closed cellular polyethylene foam and closed cellular polypropylene foam materials wherein said bubble side of one of said layers of air bubble shaped closed cellular material is positioned to face said bubble side of another of said layers of air bubble shaped closed cellular material" as generally recited in amended Claim 1 from which Claims 6-12 ultimately depend, the rejection under 35 U.S.C. § 103(a) is believed to be unwarranted and withdrawal of this rejection is respectfully requested.

The Examiner has rejected Claims 13-16 under 35 U.S.C. § 103(a) as being obvious over Kolsky.

Nowhere does Kolsky disclose or suggest a disposable surgical mat comprising, *inter alia*, a first layer and a third layer each composed of an anti-static air bubble shaped closed cellular material having a flat side and a bubble side, a second layer composed of an anti-static closed cellular polyethylene foam material between the first and third layers, and a fourth layer

composed of an anti-static polypropylene closed cellular foam material over the third layer as generally recited in Claim 13.

Rather, Kolsky merely discloses cushions or pads containing either (1) a bubble layer having two layers of a polymeric foam material of either open cell or closed cell construction thereon (FIG. 1); (2) a bubble layer interposed between two layers of a polymeric foam material of either open cell or closed cell construction thereon (FIG. 3); a bubble layer having one layer of a polymeric foam material of either open cell or closed cell construction thereon (FIG. 4); or two bubble layers wherein the bubble side of both layers are facing upwards (FIG. 11). At no point is it seen where there is any suggestion, motivation or even a hint in Kolsky of forming a mat comprising, *inter alia*, a first layer and a third layer each composed of an anti-static air bubble shaped closed cellular material having a flat side and a bubble side, a second layer composed of an anti-static closed cellular polyethylene foam material between the first and third layers, and a fourth layer composed of an anti-static polypropylene closed cellular foam material over the third layer.

In the Office Action, the Examiner alleges that “[i]t would have been obvious to one of ordinary skill in the art at the time the applicant’s invention was made to have the layers in Kolsky be in the specific arrangement as recited in Claim 13 ... since it has been held that rearranging parts of an invention involves only routine skill in the art absence of showing unexpected results.” citing *In re Japikse*, 86 USPQ 70.” However, as stated hereinabove no such holding is seen by the court in *In re Japikse*. Accordingly, Applicants again respectfully request the Examiner to identify where in *In re Japikse* such holding can be found.

Besides, it is well establish that there must be a sufficient showing of a suggestion or motivation for any modification of the teachings of a reference necessary to reach the claimed

invention in order to support the obviousness conclusion. *McGinley v. Franklin Sports Inc.*, 60 USPQ2d 1001 (CA FC 2001). As is the case here, Kolsky provides no suggestion, motivation or even a hint of modifying the cushions or pads for use as knee pads and shin guards, exercise mats, beach pads, stadium seat cushions, wheelchair cushions, bathtub liners, in luggage handles, pads for shoulder straps, or a liner material for gloves as disclosed therein to arrive at the mat as presently set forth in amended Claim 5. Thus, nothing therein would lead one skilled in the art to modify the cushions or pads of Kolsky to arrive at the presently recited mat formed from a layer of the closed cellular polyethylene foam material interposed between the layers of air bubble shaped closed cellular material and wherein said bubble side of one of said layers of air bubble shaped closed cellular material is positioned to face said bubble side of another of said layers of air bubble shaped closed cellular material.” If it is the Examiner’s position that one of ordinary skill in the art, upon inspection of Kolsky, would be motivated to form a mat as presently set forth in Claim 13, then the Examiner is respectfully requested to explain with reasons of particularity why one skilled in the art would be motivated to form the presently claimed mat.

In lacking any suggestion or motivation to form the presently recited mat, Claims 13-16 are believed to be nonobvious, and therefore patentable, over Kolsky. Accordingly, withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

The Examiner has rejected Claims 17-21 under 35 U.S.C. § 103(a) as being obvious over Kolsky in view of Small.

The deficiencies of Kolsky discussed above with respect to the rejection of Claim 13 applies with equal force to this rejection. Small does not cure and is not cited as curing the above-noted deficiencies of Kolsky. Rather, Small is merely cited for its disclosure of a base layer including a low tack adhesive bottom surface and a removable liner releasably attached to

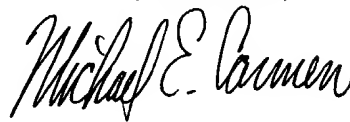
the lower surface of the low-tack adhesive and not at all to the presently claimed disposable surgical mat comprising, *inter alia*, a first layer and a third layer each composed of an anti-static air bubble shaped closed cellular material having a flat side and a bubble side, a second layer composed of an anti-static closed cellular polyethylene foam material between the first and third layers, and a fourth layer composed of an anti-static polypropylene closed cellular foam material over the third layer.

Since Kolsky and Small, alone or in combination, do not teach or suggest a disposable surgical mat comprising, *inter alia*, a first layer and a third layer each composed of an anti-static air bubble shaped closed cellular material having a flat side and a bubble side, a second layer composed of an anti-static closed cellular polyethylene foam material between the first and third layers, and a fourth layer composed of an anti-static polypropylene closed cellular foam material over the third layer as generally recited in Claim 13 from which Claims 17-21 ultimately depend, the rejection under 35 U.S.C. §103(a) is believed to be unwarranted and withdrawal of this rejection is respectfully requested.

The Examiner has rejected original Claims 22-28 under 35 U.S.C. § 103(a) as being obvious over Kolsky in view of Small. Original Claims 22-28 have been cancelled herein thus rendering this rejection moot.

For the foregoing reasons, amended Claims 1, 2, 5-21 and 30 and new Claim 31 as presented herein are believed to be in condition for immediate allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, reading "Michael E. Carmen". The signature is written in a cursive, flowing style.

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